

1632



PATENT
Customer No. 22,852
Attorney Docket No. 02481.1679-00

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10-29-01
P.2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of:)
Eugen UHLMANN *et al.*) Group Art Unit: 1632
Application No.: 09/627,787) Examiner: Richard Schnizer, Ph.D.
Filed: July 27, 2000)
For: CONJUGATES AND PROCESSES)
FOR THEIR PREPARATION AND)
THEIR USE FOR TRANSPORTING)
MOLECULES ACROSS BIOLOGICAL)
MEMBRANES)

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

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RESPONSE TO ELECTION OF SPECIES REQUIREMENT

In an Office Action dated September 25, 2001, the Examiner required election of species under 35 U.S.C. § 121 within:

- (a) aryl groups F1-F11 of claims 8 and 9;
- (b) molecules to be transported of claims 3 and 15; and,
- (c) a reactive function of claim 12.

Applicants provisionally elect, with traverse, F3 as the aryl group, oligonucleotides as the molecule to be transported, and a carboxylic acid group as the reactive function.

Applicants respectfully submit that searching the full scope of the claims would not be an undue burden in the instant application since all of the species comprise the aryl radical of claim 1 or 8. Furthermore, the number of different species recited in claims 3, 8, 9, 12, and 15 is limited. For example, claim 3 recites only three different classes of molecules to be transported, while claim 12 recites only eight different classes of reactive functions.

Pursuant to 37 C.F.R. § 1.146, should the elected species be found allowable, Applicants respectfully request that the Examiner continue to examine the full scope of the claimed subject matter to the extent necessary to determine the patentability thereof, i.e., extending the search to the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 25, 2001

By: Carol P. Einaudi
Carol P. Einaudi
Reg. No. 32,220